

REMARKS

The Official Action mailed March 27, 2002 has been received and its contents carefully noted. Filed concurrently herewith is a *Request for One Month Extension of Time*, which extends the shortened statutory period for response to July 27, 2002 (a Saturday). Accordingly, Applicant respectfully submits that this response is being timely filed on the following business day, Monday July 29, 2002.

Applicants note with appreciation the consideration of the Information Disclosure Statements filed on June 29, 1999 and October 31, 2000. Applicant have not, however, received initialed copies of the PTO Form 1449s attached to Information Disclosure Statements filed on October 25, 2000; June 4, 2001; November 30, 2001; March 7, 2002 and May 7, 2002. Consideration of these IDS documents and initialed copies of the PTO Form 1449s is respectfully requested with the following action.

It is further noted that on page 7 of the Official Action reference is made to U.S. Patent 5,275,851 to Fonash. This patent, however, does not appear to be of record in the present application in that it is not listed on any PTO Form 1449 or Form 892. Therefore, the Examiner is respectfully requested to issue a PTO Form 892 citing this reference if appropriate to be of record.

Claims 1-23 were pending in the present application. Applicant notes with appreciation the allowance of claims 6-11. Claims 1-5 and 12 have been canceled herewith and new claims 24-25 have been added to recite additional protection to which Applicant is entitled. Accordingly, claims 1-4, 6-11, and 13-25 are now pending in the subject application of which claims 6, 9-11, 13, 16 and 20 are independent. For the reasons discussed in detail below, all claims are now believed to be in condition for allowance and favorable reconsideration is requested.

Paragraph 2 of the Official Action objects to the disclosure based on various informalities in claim 12. This claim has been canceled and thus this rejection is moot.

Paragraph 4 of the Official Action rejects claims 1-5 and 12 as obvious based on the combination of U.S. Patent 5,051,570 to Tskjikawa and European Patent document EP 0 414 478 to Hamada et al. Paragraph 5 of the Official Action further rejects claims

1-5 as obvious based on the combination of U.S. Patent 5,590,555 to Yamazaki and Hamada. Claims 1-5 and 12 have been canceled and thus these rejections are moot.

Paragraph 6 of the Official Action rejects claims 13-23 as obvious based on the combination of U.S. Patent 5,590,555 to Yamazaki and Hamada. It is first noted that U.S. Patent 5,590,555 appears to be a typographical error and is not issued to Yamazaki. Rather, this is understood to be U.S. Patent 5,905,555, which is correctly listed on the PTO Form 892 attached to the Official Action. If there is any misunderstanding in this regard, clarification is requested.

As stated in MPEP § 2143-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Rejected claim 13, for example, recites first and second semiconductor islands wherein the first semiconductor island is a part of an NTFT and the second semiconductor island is a part of a PTFT. Claim 13 also recites a wiring for electrically connecting one of the impurity regions of the first semiconductor island with a second gate electrode (formed over the second semiconductor island). As the Official Action asserts, Yamazaki '555 teaches first and second semiconductor islands for an NTFT and a PTFT as recited in claim 13. Yamazaki '555 fails to teach the claimed wiring for

electrically connecting one of the impurity regions of the first semiconductor island with the second gate electrode, however, the Official Action relies upon Hamada for curing this deficiency of Yamazaki '555.

It is respectfully submitted that the Official Action has failed to show that one of skill in the art would have been motivated to combine Yamazaki and Hamada to achieve the present invention. Since the circuit of Yamazaki '555 is entirely different from the circuit of Hamada, one of ordinary skill in the art would not be motivated to combine the teachings of Yamazaki and Hamada to achieve the claimed invention. That is, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings to achieve the present invention.

As noted in MPEP § 2142:


The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

In the present application, the asserted motivation "that one transistor could drive another transistor such that the data signal turns the other transistor ON, thereby avoiding the formation of an extra scanning line" would not require the combination of Yamazaki and Hamada. Based on this motivation, one of skill in the art need look no further than Hamada for this teaching and would have found no need to consult Yamazaki. Furthermore, the fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). See MPEP 2143.01. Therefore, it is respectfully asserted that the Official Action has failed to establish a *prima facie* case of

obviousness and that claims 13-23 are in condition for allowance. Favorable reconsideration is requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,



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